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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/685,678	10/15/2003	Walter Aichholzer	510.1088	7076

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EXAMINER

TUROCY, DAVID P

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/685,678

Applicant(s)

AICHHOLZER ET AL.

Examiner

David Turocy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The finality of the office action is withdrawn based on newly applied prior art.
2. Applicant's amendments, filed 2/25/2005, have been fully considered and reviewed by the examiner. The examiner notes the amendment to the specification; therefore the objection to the specification has been withdrawn. The examiner notes the amendment to claim 1 and the subsequent cancellation of claim 2. Claims 1 and 3-9 are pending.

Response to Arguments

3. Applicant's arguments, filed 2/25/2005, with respect to the rejection(s) of claim(s) 2-3 under 35 USC 103 (a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of US Patent 5425970 by Lahrmann et al.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6132864 by Kiriazis et al ("Kiriazis") in view of US Patent 5425970 by

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Lahrmann et al ("Lahrmann") and further in view of U.S. Patent No 4810540 by Ellison et al ("Ellison").

Claim 1: Kiriazis teaches of a method of producing a film with several coating layers for automobile manufacturing (Abstract). Kiriazis discloses coating a support layer with a first coating comprising a filler composition, a second coating comprising a pigmented paint layer, and a subsequent transparent coating layer (Abstract). However, Kiriazis fails to disclose the thickness of the first coating and the relative thickness of the first layer being a factor of 3 to 5 times greater than that of the second layer.

However, Lahrmann teaching of a similar multi-layer coating, discloses applying a filler composition to a thickness of 35 microns, within the range as claimed, and a second coating thickness of 10 microns (Example 5). Therefore Lahrmann discloses applying a first coating thickness 3.5 times larger than the second thickness, which is within the range as claimed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kiriazis to use the relative coating thicknesses as suggested by Lahrmann to provide a desirable multilayered coating film because Lahrmann discloses a filler coating thickness of 35 microns followed by a basecoat thickness of 10 microns is known in the art to provide multi-layered coating and therefore would reasonably be expected to effectively provide a multi-layered film.

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Kiriazis discloses applying the coatings by spraying, roller coating, or knife coating (Column 3, lines 29-30). However, Kiriazis in view of Lahrmann fails to disclose application of the first layer by knife coating, rolling, pouring, or printing and the second layer by atomization.

However, Ellison discloses a method of making a multi-layered film. Ellison discloses applying the first coat by rolling and a subsequent second coat by spraying (Figure 3).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kiriazis in view of Lahrmann to apply the first layer by rolling and the second layer by spraying as suggested by Ellison to provide a desirable multi-layered film because Ellison discloses roll coating a first layer onto a support material and spraying a second coating layer is known in the art to provide multi-layered films and therefore would reasonably be expected to effectively provide a multi-layered film for application in automobile manufacturing.

Claim 3: Kiriazis in view of Lahrmann and further in view of Ellison fails to teach of a transparent outer layer formed by UV curing varnish.

However, Lahrmann disclosing a similar multi-layered film for application to automotive vehicles, similar to the film disclosed by Kiriazis. Lahrmann discloses applying an outer UV curable transparent outer layer (Column 1, lines 5-8 Column 3, lines 64-65).

The examiner maintains that the outer layer of the film taught by Lahrman provides the same function as that provided by the outer layer of Kiriazis. Since both Lahrman and Kiriazis disclose a transparent layer on multilayered films, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Kiriazis in view of Lahrman and further in view of Ellison to use the UV curable transparent outer layer as suggested by Lahrman to provide a desirable multi-layered film for application to an automotive vehicle because Lahrman discloses a UV curable varnish is known in the art to provide a transparent outer layer on a multilayer film for application to an automotive vehicle. The selection of something based on its known suitability for its intended use has been held to support a *prima facie* case of obviousness. *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See MPEP 2144.07.

Claim 4: Kiriazis discloses applying the paint layer onto the filler coating in the uncured state, i.e. wet-on-wet, and cure the first and second coating together (Column 3, lines 20-23).

Claim 5: Kiriazis discloses curing the first coat prior to application of the second coating layer (Column 3, lines 13-18).

Claim 6: Kiriazis discloses applying the films to automotive vehicles (Column 1, lines 5-7).

Claim 7: Kiriazis in view of Lahrmann and further in view of Ellison fails to teach a support thickness from 100 to 1200 microns. However, Kiriazis teaches of a support material having a thickness of from 10 to 500 microns (Column 1, lines 41-43). A prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness. *In re Peterson*. See MPEP 2144.05.

Claim 8: Kiriazis in view of Lahrmann and further in view of Ellison fails to teach a support thickness from 700 to 1200 microns.

The examiner notes, "the component including a polymer material", merely recites intended use. Kiriazis in view of Lahrmann and further in view of Ellison discloses a multi-layered film of similar thickness and pliability to that claimed by applicants. Therefore the examiner maintains that the product disclosed by Kiriazis in view of Lahrmann and further in view of Ellison is capable of being applied to a polymer material.

Kiriazis discloses a multi-layered film with a support material having a thickness of from 10 to 500 microns (Column 1, lines 41-43). A *prima facie* case of obviousness exists where the claimed ranges and prior art do not overlap but are close enough that one in ordinary skill in the art would have expected them to have the same properties. *Titanium Metals Corp. of America v. Banner*, 778 f.2d 775, 227 USPQ 773 (Fed. Cir. 1985). See MPEP 2144.05. It is the examiners position that a film thickness of 700

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microns provides the similar properties of that of 500 microns. It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize thicknesses, close to the referenced range, that have the same properties.

Claim 9: Kiriazis in view of Lahrmann and further in view of Ellison fails to teach a support thickness from 50 to 300 microns.

Kiriazis discloses a multi-layered film with a support material having a thickness of from 10 to 500 microns, where the films are predominately applied to metals substrates (Column 1, lines 41-43, Column 3, lines 40-41). In the case where the claimed ranges "overlap or lie" inside ranges disclosed by prior art a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257 191 USPQ 90. See MPEP 2144.05. Since both Ellison and Kiriazis both teach of similar multi-layer films, it would be obvious to one of ordinary skill in the art at the time the invention was made to utilize a support material within the claimed range.

Conclusion

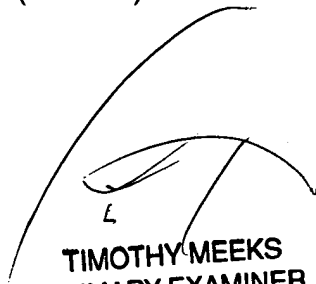
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy
AU 1762



TIMOTHY MEEKS
PRIMARY EXAMINER